

REMARKS/ARGUMENTS

Reconsideration and withdrawal of the rejection of all the claims now in the application (i.e. Claims 1-13 and 18-27) is respectfully requested in view of the foregoing amendments and the following remarks.

Initially, the Examiner rejected claims 9-13 as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. Applicant has amended claim 9 to make it clear that the retainer includes the second planar portion and has made similar amendments in claims 10-13 as well as deleting the reference to the support in claim 10 and substituting the first planar portion therefore. These changes were made to make it clear that the support has the first and second planar portions. Claims 18, 19, 20, 23 and 24 have been amended to clarify that the support includes the first and second portions. Other minor amendments have been made to put the claim in better form. These changes do not affect the scope of the claim.

The Examiner went on to reject claims as anticipated by U.S. Patent No. 6,302,286 or by Design Patent No. 353,328. The '286 patent is directed to a baby bottle cover and the design patent apparently relates to a soda can cover.

Applicant has amended independent claims 1 and 18 to make it clear that the instrument in question is used in an acetabular cup part of a prosthetic total hip joint, the parts of which appear both in the preamble and the body of the claims. As such, it is submitted that the preamble of the claim is a claim limitation and distinguishes over both the '286 and '328 references. Neither of these references are directed to the field of orthopedics and, even if the structural limitations of the claim were suggested by these references, one skilled in the orthopedic art would not look to the baby bottle or can top art for guidance in designing a handling instrument for an acetabular cup. It should be noted that claim 18 requires a "handle" and neither of the two references disclose a first portion, including a handle portion for manipulating the acetabular cup.

The reliance on the preamble as a limitation to distinguish over the prior art renders the preamble a claim limitation is stated in *Invitrogen Corp. v. Biocrest Manufacturing, L.P.*, 327 F.3d 1364, 66 U.S.P.Q.2d 1631 (Fed. Cir. 2003). In addition, the preamble of claims 1 and 18 provides antecedents for the ensuing claim language which has been held to limit the scope of the claims to use with a prosthetic acetabular cup, *see for example, Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 65 U.S.P.Q. 2d. 1981 (Fed.

Cir. 2003). Thus, the preamble of both independent claims 1 and 18 distinguishes over the prior art cited by the Examiner.

It is applicant's position that the above places the claims in condition for allowance since the claims now clearly distinguish over the two references relied upon the Examiner. Alternatively, the amendments place the claims in better condition for appeal.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he/she telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefore.

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Respectfully submitted,

By 

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